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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,989	12/13/2001	Gary J. Gracyalny	18367-9631-00	7644

7590 09/14/2004
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EXAMINER

MILLER, CARL STUART

ART UNIT	PAPER NUMBER
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3747

DATE MAILED: 09/14/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,989

Applicant(s)

GRACYALNY ET AL.

Examiner

Carl S. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-53 is/are pending in the application.
4a) Of the above claim(s) 20, 21, 23 and 24 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-19, 22 and 25-53 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

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Claims 20-21 and 23-24 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9. The restriction requirement is hereby made final.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1-2, 4, 14-17, 19, 33 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyamoto.

In particular, Miyamoto teaches controlling flow to and from a fuel tank with two valves operated in parallel and in the same housing (one being a vent valve).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 6 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto in view of Sierk.

Miyamoto teaches two parallel valves mounted in the same housing, one closing a fuel flow conduit and the other controlling a vent. The valves are for a portable

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engine such as one that would be used on a lawnmower, generator or pressure washer.

Single cylinder engines are the norm in the art, but a multi-cylinder engine would have been an obvious choice for an application such as a generator which might require more power output than a typical lawnmower.

Sierk teaches a purely mechanical linkage used to turn a valve that stops fuel flow to an engine.

It would have been obvious to modify Miyamoto by using a purely mechanical actuator to close the valves because this would have been a mere mechanical expedient commonly used in the art for the same purpose.

Claims 8 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto and Sierk as applied to claim 1 above, and further in view of Nofel.

Nofel teaches the commonly known safety feature of stopping a blade on a small engine when the engine itself is stopped, thereby making this an obvious feature to add to the Miyamoto device.

Claims 38, 39, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto and Sierk as applied to claim 1 above, and further in view of Adams.

Adams teaches a vent on a small portable engine gas tank which includes baffle means to keep gasoline from splashing out through the vent, thereby making the use of a baffle on the vent of Miyamoto obvious.

Claims 9-13, 18, 26, 28, 29, 30-32 rejected under 35 U.S.C. 103(a) as being unpatentable over Miyamoto.

In particular, these claims involve intended uses for a small portable engine that would have been obvious uses known to one of ordinary skill in the art.

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The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-19, 22 and 25-53 are rejected under the judicially created doctrine of double patenting over claims 1-50 of U. S. Patent No. 6,691,683 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: An inspection of the already patented claims shows that these claims differ from the claims in the instant case only by the fact that each independent claim of 6,691,683 includes a limitation that at least one of the valves is opened and closed electrically. This means, of course, that a statutory double patenting rejection would be inappropriate, but that the claims of the current application would have been obvious in view of those of the patented case. The pending and patented claims have not been matched claim for claim since this appears unnecessary in view of the explanation found above.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.


Applicant's arguments filed January 15, 2004 have been fully considered but they are not persuasive. In particular, the ignition control claims have now been allowed (exclusive of the double patenting rejection) however the claims that require only a manual input have now been rejected under 35 U.S.C. 102, thus making this a non-final action. These claims do not require the Sierk linkage at all (as pointed out in the applicant's response).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carl S. Miller whose telephone number is 703-308-2653. The examiner can normally be reached on MTWTHFR.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry YUEN can be reached on 703-308-1946. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Carl S. Millic
Primary Examiner